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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,427	02/15/2002	Sam M. Jyawook	67,064-001	3582

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EXAMINER
VO, HAI

ART UNIT	PAPER NUMBER
1771	6

DATE MAILED: 08/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/077,427	Applicant(s) JYAWOOK ET AL.	
	Examiner Hai Vo	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 May 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 15-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7 and 15-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. Non-elected claims 8-14 have been canceled in the amendment received on 05/20/2003.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 3-7, 15 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olson (US 4,064,654) in view of Park et al (US 6,051,174). Olson teaches a weather stripping comprising a substrate and outer skin made of a cellular foamed material (abstract, figures 5a-5d). Olson teaches the substrate and the skin layer having a cross sectional dimension that selectively varies along a length of the weather stripping (figures 5a-5d). Olson does not specifically disclose the entire weather stripping formed from a microcellular material. Park teaches a microcellular foamed material having a cell size of 0.1 to 1 micron and a cell density ranging from 10^{12} to 10^{15} cells per cubic centimeter (column 2, lines 56-58). Park discloses that with microcellular plastics, one can use less polymer thereby substantially reducing material costs while maintaining mechanical properties (column 2, lines 50-55), which is important to the invention of Olson. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the cellular foamed material in Olson by a microcellular foamed material as taught in Park motivated by the

desire to reduce the production cost without sacrificing the mechanical properties of the materials, which is important to invention of Olson, thus suggesting the modification.

With regard to claim 15, it is the examiner's position that the article of Olson as modified by Park is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity (the sealing portion and base portion made of a microcellular foamed material). Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. ***In re Thorpe***, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. ***In re Marosi***, 218 USPQ 289,291 (Fed. Cir. 1983). The Olson/Park reference strongly suggests the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Olson/Park.

4. Claims 2 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olson (US 4,064,654) in view of Park et al (US 6,051,174) as applied to claims 1 and 15 above, further in view of Hendrix et al (US 6,458,301). Neither Olson nor Park suggests or discloses the weather stripping formed from thermoplastic vulcanizates. Hendrix teaches a weatherseal having the gripping portion and sealing portion made of foamed thermoplastic vulcanizates (column 4, lines 15-33). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the rubber foamed material in Olson by a foamed thermoplastic vulcanizate as taught in Hendrix motivated due to their ability to be extruded and molded several times without loss of performance characteristics, which is important to the invention of Olson, thus further suggesting the modification.

5. Claims 1-7, and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendrix (US 6,458,301) in view of Park et al (US 6,051,174). Hendrix teaches a weatherseal having the gripping portion and sealing portion made of foamed thermoplastic vulcanizates (column 4, lines 15-33). Hendrix teaches the gripping and sealing portions having a cross sectional dimension that selectively varies along a length of the weather stripping (figures 2-4). Hendrix does not specifically disclose the entire weather stripping formed from a microcellular material. Park teaches a microcellular foamed material having a cell size of 0.1 to 1 micron and a cell density ranging from 10^{12} to 10^{15} cells per cubic centimeter (column 2, lines 56-58). Park discloses that with microcellular plastics,

one can use less polymer thereby substantially reducing material costs while maintaining mechanical properties (column 2, lines 50-55), which is important to the invention of Hendrix. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the cellular foamed material in Hendrix by a microcellular foamed material as taught in Park motivated by the desire to reduce the production cost without sacrificing the mechanical properties of the materials, which is important to invention of Hendrix, thus suggesting the modification.

With regard to claim 15, it is the examiner's position that the article of Hendrix as modified by Park is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity (the sealing portion and base portion made of a microcellular foamed material). Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. ***In re Thorpe***, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. ***In re Marosi***, 218 USPQ 289,291 (Fed. Cir. 1983). The Olson/Park reference strongly suggests the claimed subject matter. It is noted

that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Hendrix/Park.

6. Claims 1, 3-7, 15, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over a commercial product, thermwell 17 ft. white cellular rubber weather strip, sold in Home Depot in view of Park et al (US 6,051,174). The cellular rubber weather stripping comprising a substrate and outer skin made of a cellular foamed material, wherein the substrate and the skin layer having a cross sectional dimension that selectively varies along a length of the weather stripping (see figure). Park teaches a microcellular foamed material having a cell size of 0.1 to 1 micron and a cell density ranging from 10^{12} to 10^{15} cells per cubic centimeter (column 2, lines 56-58). Park discloses that with microcellular plastics, one can use less polymer thereby substantially reducing material costs while maintaining mechanical properties (column 2, lines 50-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the cellular foamed material in the white cellular rubber weather strip by a microcellular foamed material as taught in Park motivated by the desire to reduce the production cost without sacrificing the mechanical properties of the materials.

With regard to claim 15, it is the examiner's position that the article of the thermwell weather stripping as modified by Park is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity (the sealing portion and base portion made of a microcellular foamed material). Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. ***In re Thorpe***, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. ***In re Marosi***, 218 USPQ 289,291 (Fed. Cir. 1983). The Thermwell weather stripping /Park reference strongly suggests the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Thermwell weather stripping /Park.

Response to Arguments

7. Applicant's arguments with respect to claims 1-7, and 15-20 have been considered but are moot in view of the new ground(s) of rejection.

8. The art rejections have been overcome by the present amendment and response.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Tue-Fri, 8:30-6:00 and on alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The

fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
July 28, 2003

TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700